

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed June 6, 2006. Claims 1, 3-5, 11, 13-15, 17, 20, and 22 are pending in the application. Claims 1, 3-5, 11, 13-15, 17, 20, and 22 were rejected. For the reasons discussed below, Applicant respectfully requests reconsideration and favorable action in this case.

Section 101 Rejections

The Examiner rejects Claims 1, 3-5, 11, 13-15, 17, 20, and 22 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. More specifically, the Examiner asserts that the claims are directed to a computer program that is not embodied on a computer-readable medium. However, instead of making such an amendment to all of the claims, Applicant has amended Claims 1, 3-5, 11 and 13-14 to more clearly state a method and not a computer program and has amended Claims 15, 17, 20 and 22 to recite software embodied on a computer-readable medium. Applicants believe that these amendments to the claims address the Examiner's rejection and thus respectfully request reconsideration and allowance of these claims.

The Examiner also rejects Claims 1, 3-5, 11, 13-15, 17, 20, and 22 under 35 U.S.C. § 101 because the claimed invention lacks patentable utility. The patent laws define patentable subject matter as "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto." *See* 35 U.S.C. § 101. When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete, and tangible result. This then satisfies the requirements of 35 U.S.C. § 101. *See In re Alappat*, 33 F.3d 1526, 1544, 31 U.S.P.Q.2d 1545, 1557 (Fed. Cir. 1994); *see also State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 U.S.P.Q.2d 1596, 1601-02 (Fed. Cir. 1998). While an abstract idea by itself may not satisfy the requirements of 35 U.S.C. § 101, an abstract idea when practically applied to produce a useful, concrete, and tangible result satisfies 35 U.S.C. § 101. *See AT&T Corp. v. Excel Comm. Inc.*, 172 F.3d 1352, 1357, 50 U.S.P.Q. 1447, 1452 (Fed. Cir. 1999) (stating that as technology progressed, the CCPA overturned some of the earlier limiting principles regarding 35 U.S.C. § 101 and announced

more expansive principles formulated with computer technology in mind); *see also In re Musgrave*, 431 F.2d 882, 167 U.S.P.Q. 280 (CCPA 1970) (cited by the Federal Circuit in *AT&T Corp.*, 172 F.3d at 1356). Thus, producing a useful, concrete, and tangible result is the key to patentability according to *State Street* and other applicable case law.

“Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.” M.P.E.P. § 2106. Indeed, a method or process remains statutory even if some or all of the steps therein can be performed in the human mind, with the aid of the human mind, or because it may be necessary for one performing the method or process to think. *See In re Musgrave*, 431 F.2d at 893, 167 U.S.P.Q. at 289. As stated by the Federal Circuit in *State Street* and as explicitly confirmed in the M.P.E.P., “[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces ‘a useful, concrete, and tangible result’ -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.” *State Street*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601-02; M.P.E.P. § 2106.

Applicants’ claims are not merely manipulations of abstract ideas. Instead, each of Applicants’ claims clearly recites a useful, concrete, and tangible result, which is all the law requires for a claim to be directed to statutory subject matter, and is therefore directed to patentable subject matter.¹ For example, independent Claim 1 recites “causing any header parameters associated with an upgraded protocol to be removed from said header

¹ Applicants note that to the extent the Examiner bases any part of this rejection on a “technological arts” requirement, the Board of Patent Appeals and Interferences, in a precedential opinion, recently determined that no “technological arts” requirement exists under 35 U.S.C. § 101. *See Ex Parte Lundgren*, 2004 WL 3561262, *5, Appeal No. 2003-3088 (Bd. Pat. App. & Int. 2004) (also available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/2003-2088.pdf>) (reversing an examiner’s rejection under 35 U.S.C. § 101 and stating that “[o]ur determination is that there is currently no judicially recognized separate ‘technological arts’ test to determine patent eligible subject matter under § 101” and “we decline to create one”). Thus, Applicants respectfully submit that a rejection based on a “technological arts” requirement is or would be improper.

portion” and “interpreting said received header according to said legacy protocol.” Thus, modifying headers associated with an upgraded protocol so that they can be interpreted according to a legacy protocol is one practical application of independent Claim 1, the useful, concrete, and tangible result being a modified header that is able to be interpreted according to the legacy protocol. The other claims of the present application have a similar practical application and utility.

For at least the foregoing reasons, Applicant respectfully submits that 1, 3-5, 11, 13-15, 17, 20, and 22 recite statutory subject matter and claim inventions that have patentable utility. Therefore, Applicant respectfully requests reconsideration and allowance of Claims 1, 3-5, 11, 13-15, 17, 20, and 22.

CONCLUSION

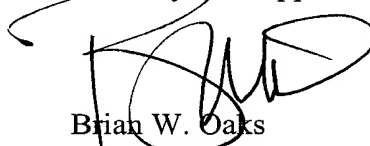
Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all the pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant



Brian W. Oaks
Reg. No. 44,981

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Correspondence Address:

Customer Number: 05073